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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,855	06/20/2001	David Alexander Learmonth	AAT-12563	4106

7590 01/27/2004
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EXAMINER

FORD, JOHN M

ART UNIT PAPER NUMBER

1624

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DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. <u>09/885833</u>	Applicant(s) <u>Learmonth et al</u>
Examiner <u>J. M. Ford</u>	Group Art Unit <u>1624</u>

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on Nov 17, 2003

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 3, 5, 10-31, 46, 47 and 51-58 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1, 3, 5, 10-31, 46, 47 and 51-57 is/are allowed.
- ☒ Claim(s) 58 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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Applicants' response of Nov. 17, 2003, is noted.

The claims in the application are claims 1, 3, 5, 10-31, 46, 47 and 51-58.

Claims 1, 3, 5, 10-31, 46, 47 and 51-57 are allowed.

A method of treating some central or peripheral nervous system disorders is not specific enough to meet the Utility Guidelines. The use of "such as" in a claim is not acceptable; Ex parte Cardova, 10 U.S.P.Q. 2nd 1949. Claim 58 is rejected under 35 U.S.C. 112, 1st paragraph, Parkinson disease has no established *regimen* of treatment.

All mood disorders is too broadly stated. Seasonal effective disorders are included therein. Light effective disorders are included. Gastrointestinal disturbances has *many* causes; stress, acid meal, contaminated food.

The uses here are not specific. Reduction in the O-methylation of catechol amines is a laboratory screen test.

The recent utility guideline_s set by PTO require applicants to meet the requirements as stated in Brenner v. Manson in, 148 USPQ 689, which requires that utility be developed to a point where "specific benefits exist in currently available form". Similar is the "immediate benefit to the public" standard that Nelson v. Bowler, 206 USPQ 880 refers to. The standard set forth in the concurring opinion of In re Hartop, 135 USPQ 419 is "whether the invention has been brought to such perfection as to be capable of practical employment". This language is echoed in Bindra vs. Kelly, 206 USPQ 570.

A broad disclosure of utility, as in the cited claims, cannot be deemed in compliance with 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph. The treatment of

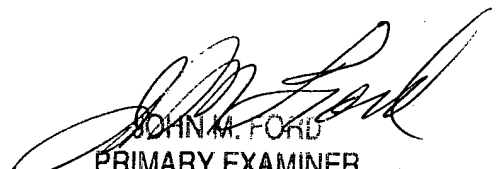
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hypertension – is suggested. The PTO has amended the guidelines to clarify “specific utility”.

The Court focused on the fact that the applicant failed to identify a “specific utility” in *Brenner v. Manson*.

This requirement of one specific utility, is consistent with Unity of Invention Practice in International Applications and National Phase Applications under 35 U.S.C. 371, and PCT Rule 13.2 for PCT applications.

Therefore, applicants should rewrite claim 58 to a “specific utility”.


JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT 1624

Ford/LR
January 21, 2004